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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/068,167	02/05/2002	Terrance D. Peabody	IOI-389	8049

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HOUSTON, TX 77042

EXAMINER
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MARMOR II, CHARLES ALAN

ART UNIT	PAPER NUMBER
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3736

DATE MAILED: 08/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/068,167

Applicant(s)

PEABODY ET AL.

Examiner

Charles A. Marmor, II

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3-10,12-18,30 and 32-38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1,3-9,12-15,34,36 and 37 is/are allowed.
- 6) ☒ Claim(s) 10,16,17,30,32,33,35 and 38 is/are rejected.
- 7) ☒ Claim(s) 18 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This Office Action is responsive to the Amendment filed May 13, 2005. The Examiner acknowledges the amendments to claims 1, 3, 4, 10, 12 and 30 and the cancellation of claims 19-26, 28 and 29. Claims 1, 3-10, 12-18, 30 and 32-38 are pending.

#### ***Claim Objections***

2. Claim 17 is objected to because of the following informalities: at line 2, "about" apparently should read --abut--. Appropriate correction is required.

#### ***Claim Rejections - 35 USC §102***

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claims 30, 32 and 33 are rejected under 35 U.S.C. 102(b) as being anticipated by Hodge ('178). Hodge teaches a measuring device to facilitate an orthopedic procedure. The device includes a marking guide (94) capable of guiding the marking of the side of a bone member; a stop plate for abutting an end of a desired bone member (50); a ruler (100) coupled to the marking guide and to the stop plate and that provides an indication of the distance between the marking guide and the stop plate; and a locking mechanism at lock screw (46) that cooperates with the ruler to control selective adjustment of the distance between the marking guide and the stop plate by moving the stop plate with respect to the ruler. The marking guide and the stop

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plate are themselves noninvasive, and therefore are capable of being utilized in a manner noninvasive to the bone tissue. An abutment surface of the stop plate (50) abuts an end portion of the bone (see 18 in Figure 2). The abutment surface is located on both sides of the ruler in a plane that is generally transverse to the longitudinal direction of the ruler (see Fig. 2). The noninvasive stop plate may be pivoted (see column 4, lines 5-21).

4. Claims 10, 16, 17, 35 and 37 are rejected under 35 U.S.C. 102(b) as being anticipated by Knebelman ('850). Knebelman teaches a measurement member that is capable of assisting in locating a prosthetic device during an orthopedic procedure. The measurement member includes a marking guide (19); a stop plate (23); a ruler (11) coupled to the marking guide and to the stop plate; and a locking mechanism at clamp (27) that cooperates with the ruler to permit selective adjustment of the distance between the marking guide and the stop plate by moving the stop plate with respect to the ruler (11). The marking guide and the stop plate are noninvasive, and therefore are capable of being utilized in a manner noninvasive to the bone tissue. The claim language does not define any particular structure characteristic of the respective marking guide and stop plate, therefore, since surface (19) is capable of guiding marking of a bone member and since plate (23) is capable of being used as a stop member, these elements meet the claim limitations. The stop plate is pivotable with respect to the ruler when the screw (27) does not extend into slot or groove (29). The stop plate is configured such that it is capable of abutting the distal femoral condyles or the proximal end of a tibia. The ruler is a rigid member that extends the full length between the marking guide and the stop plate. When the longitudinal axis is

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defined as a line extending through the center of the ruler, the abutment surface is generally symmetric with respect to both sides of the longitudinal axis.

*Allowable Subject Matter*

5. Claims 1, 3-9, 12-15, 34, 36 and 37 are allowed.

6. Claim 18 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

7. The following is a statement of reasons for the indication of allowable subject matter:

Regarding claims 1, 3-9, 34, 36 and 37, no prior art of record teach or fairly suggest a measuring guide for assisting in locating a prosthetic device, as claimed by Applicant, where a stop plate including an abutment surface configured to abut a bone where the stop plate is pivotably coupled to a locking mechanism to permit positioning of the stop plate at desired angles with respect to the ruler and where the abutment surface is positioned on both sides of the ruler.

Regarding claims 12-15, no prior art of record teach or fairly suggest a measuring guide for noninvasive measurement of bone tissue, as claimed by Applicant, where the locking mechanism includes a block with an opening for slidably receiving the ruler and a spring-loaded release mechanism biased toward engagement with the ruler to lock the position of the ruler with respect to the lock.

***Response to Arguments***

8. Applicant's arguments, see pages 12, 13, 15 and 16 of the amendment filed May 13, 2005 with respect to the rejection of claims 1, 3-7, 10, 16-18, 30 and 32-38 under 35 USC 102(b) as anticipated by Cosbie; the rejection of claims 30 and 32 under 35 USC 102(b) as anticipated by Knebelman; and the rejection of claims 1, 3-6, 10, 16-18, 30, 32 and 36-38 under 35 USC 102(b) as anticipated by Gilmer. Applicants have been fully considered and are persuasive. The aforementioned claim rejections have been withdrawn.

9. Applicant's arguments filed May 13, 2005 with respect to the rejections of claims 30, 32 and 33 under 35 USC 102(b) as anticipated by Hodge and claims 10, 16, 17, 35 and 38 under 35 USC 102(b) as anticipated by Knebelman have been fully considered but they are not persuasive.

Applicant contends that the Hodge reference fails to disclose a means for abutting that comprises a pivotable stop plate with an abutment surface configured to abut a bone, wherein the abutment surface is located on both sides of the ruler in a plane that is generally transverse to the longitudinal direction of the ruler. This argument is not persuasive. The Examiner respectfully submits that the stop plate is considered to be element 50. The abutment surface of element 50 abuts an end portion of the bone at 18 as illustrated in Figure 2. The stop plate 50 may be pivoted (see column 4, lines 5-21). Figure 2 also illustrates that the stop plate is disposed generally transverse to the longitudinal direction of the ruler. Figures 1, 3 and 4 illustrate that the abutment surface is located on both sides of the ruler. In view of the foregoing, the rejection of claims 30, 32 and 33 under 35 USC 102(b) as anticipated by Hodge has been maintained.

Applicant contends that Knebelman fails to disclose the measuring guide that includes, *inter alia*, a stop plate that is pivotable with respect to a pivot point and a pivotable stop plate, with an abutment surface configured to abut a bone, where the abutment surface is located on both sides of the ruler in a plane that is generally transverse to the longitudinal direction of the ruler. These arguments are not persuasive. The Examiner respectfully submits that stop plate is pivotable with respect to a pivot point on the ruler defined by the longitudinal axis that extends through the center of the ruler. *Merriam Webster's Collegiate Dictionary, Tenth Edition* (1996) defines "pivot" as a "shaft or pin on which something turns" and "turning on or as if on a pivot." In view of this definition, the stop plate of Knebelman can be considered to pivot or turn as if on a point formed by the longitudinal axis of the ruler at a location where the stop plate is positioned. Moreover, the stop plate of Knebelman can be considered the claimed "stop plate" because it meets all of the structural limitations of the claims in that it has a surface that may be considered an abutment surface that is generally symmetric with respect to both sides of a longitudinal axis extending through the center of the ruler. In view of the foregoing, the rejection of claims 10, 16, 17, 35 and 38 under 35 USC 102(b) as anticipated by Knebelman has been maintained.

### ***Conclusion***

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

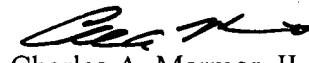
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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles A. Marmor, II whose telephone number is (571) 272-4730. The examiner can normally be reached on M-TH (7:00-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on (571) 272-4726. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Charles A. Marmor, II  
Primary Examiner  
Art Unit 3736

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